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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,203	02/19/2004	Chris D. Cote		4091

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/782,203

Applicant(s)

COTE, CHRIS D.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02182004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 contains the trademark/trade name Velcro™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe hook and loop fastening means and, accordingly, the identification/description is indefinite.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoner 5,987,778. Stoner '778 discloses all the limitations of the claims including the following: a body of flexible, stretchable waterproof material 14 having a substantial linear first edge (see one edge in back of boot in Figure 4); a substantially linear second edge (next to first edge in back of boot) at a portion of the body opposite the first edge; a curvilinear top edge 34 connecting the first side edge to the second side edge; a curvilinear bottom edge (near 27) opposite the top edge and connecting the first side edge to the second side edge; a first connecting means 30 adjoining the first side edge; a second connecting means 28 adjoining the second side edge and adapted to connect with the first side edge; an ankle portion (portion below 27 in Figure 4) adjoining the top edge; a toe portion (front of protector, see Figure 4) adjoining a central portion of the bottom edge; a transition portion (in metatarsal area of foot) in a region of the body lying between the ankle portion and the toe portion; means for connecting a first portion of the toe portion to a second portion of the toe portion 45; the first side edge connection is connected to the second side edge connection (28 fastened to 30 to close cover); the first and second portions of the toe portion are connected by connecting means (see Figure 6) and the shoe protector is stretched lightly over the shoe in a watertight manner (see col. 4, lines 18-22); the first side edge connection and the second side edge connection are formed of complimentary elongated strips of Velcro™ positioned adjacent their respective side edges (see Figure 4) ; the connecting means comprises a flexible but relatively unstretchable elongated strip material 28; the elongated strip is further provided with a plurality of connection (hook and loop material) and wherein the shoe protector further comprises a plurality of protrusions (opposite portion of hook and loop) connectively adapted to be connected to the elongated strip by the connections.

4. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsen 5,950,333. Tsen '333 discloses all the limitations of the claims including the following: a body of flexible, stretchable waterproof material 180 having a substantial linear first edge (see back heel portion in Figure 1); a substantially linear second edge (opposite the first in the back heel portion in Figure 1) at a portion of the body opposite the first edge; a curvilinear top edge (top edge portion in the leg area in Figure 1) connecting the first side edge to the second side edge; a curvilinear bottom edge (see Figure 3, bottom edge near bottom of sole) opposite the top edge and connecting the first side edge to the second side edge; a first connecting means 182 adjoining the first side edge; a second connecting means (other 182) adjoining the second side edge and adapted to connect with the first side edge; an ankle portion adjoining the top edge (located around 181); a toe portion (area near 15 in Figure 1) adjoining a central portion of the bottom edge; a transition portion (covering metatarsals) in a region of the body lying between the ankle portion and the toe portion; means 34 for connecting a first portion of the toe portion to a second portion of the toe portion; the first side edge connection is connected to the second side edge connection (see Figure 2 at 182); the first and second portions of the toe portion are connected by connecting means 34 and the shoe protector is stretched lightly over the shoe in a watertight manner (see last line of Abstract); the first side edge connection and the second side edge connection are formed of complimentary elongated strips of Velcro™ (see col. 2, lines 22-27) positioned adjacent their respective side edges; the connecting means comprises a flexible but relatively unstretchable elongated strip material 19; the elongated strip is further provided with a plurality of connection (hook and loop material) and wherein the shoe protector further

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comprises a plurality of protrusions (opposite portion of hook and loop) connectively adapted to be connected to the elongated strip by the connections.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of the references as applied to claim 3 above in view of Hetrick 1,018,708. Either of the references as applied to claim 3 above discloses all the limitations substantially as claimed except for the end portions of the elongated strip is wider at the ends than in the central part and the central part of the strip, on one side, having protrusions for preventing slipping. Hetrick '708 teaches that a strip 15 holding a shoe protector to a shoe, can have protrusions (Spurs 23) depending from it that aid in gaining traction and that the center portion (located in the center of the spurs 23 in Figure 2) to aid in better fitting the cover to the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the strip of either of the references as applied to claim 3 above, thinner in the center than the ends to allow the cover to better fit the user's shoe and to place protrusions on the strap to aid in gaining grip, as taught by Hetrick '708.

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7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of Stoner 5,987,778 or Tsen 5,950,33 as applied to claim 3 above. Each of the references as applied to claim 3 contain hook and loop fasteners, which are known to be typically made of woven nylon. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the hook and loop fasteners of the references as applied to claim 3 above, out of nylon, as is known for Velcro™ strips.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

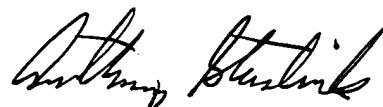
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is fluid and cursive, with the first name "Anthony" and last name "Stashick" clearly distinguishable.

Anthony Stashick  
Primary Examiner  
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ADS